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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,103	09/08/2003	Gernod Fritzs	MAN-010	9953
28661	7590	10/24/2005	EXAMINER	
SIERRA PATENT GROUP, LTD. P O BOX 6149 STATELINE, NV 89449			PRONE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			3738	
DATE MAILED: 10/24/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/658,103	Applicant(s) FRITZSCH, GERNOD	
	Examiner Christopher D. Prone	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites that the driven working element and the fixed position working element form a working space between them, which has a cutting edge. The claim is deemed indefinite because it refers to a space comprising a cutting edge. The applicant is advised to further define the location of the cutting edge.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent 5,346,469 Ikeda.

In reference to claim 1, Ikeda discloses the same invention being a surgical ultrasonic instrument comprising a housing (11) which has an ultrasonic transducer (50), a shaft (6) connected to the housing (11) and having a working element (14) driven

by the ultrasonic transducer (50) in an oscillating manner in the axial direction of the shaft and a working element (21) with a fixed position in the axial direction, with the fixed position working element (21) being immovably connected to the shaft (6), and the fixed position working element (21) and the driven working element (14) forming a working space (7) between them, which comprises a cutting edge located at the tip of (14), shown in figures 1-10 of Ikeda.

In reference to claim 2, Ikeda discloses the same invention wherein the fixed position-working element (21) is part of a protective sleeve shown in figures 1-10 of Ikeda.

In reference to claim 3, Ikeda discloses the same invention wherein the movable working element (14) emerges from an end face opening provided in the fixed position working element (21) shown in figures 1-10 of Ikeda.

In reference to claim 4, Ikeda discloses the same invention wherein the fixed position-working element (21) has an end face extending obliquely to the axial direction and/or has an end face which is planar overall shown in figures 1a-1d, 5a-5b, and 9a-10b of Ikeda.

In reference to claim 5, Ikeda discloses the same invention wherein the fixed position working element (21) and the movable working element (14) are substantially of the same length at the distal end in the axial direction shown in figure 5b of Ikeda.

In reference to claim 6, Ikeda discloses the same invention wherein the fixed position-working element (21) has an end face, which is differently inclined relative to the longitudinal axis of the instrument shown in figures 1b-1d of Ikeda.

In reference to claim 7, Ikeda discloses the same invention wherein the fixed position working element (21) tapers laterally in comparison with the shaft (6) shown in figures 1b-1d of Ikeda.

In reference to claim 9, Ikeda discloses the same invention wherein the movable working element (14) tapers conically in the distal direction shown in figures 3-4b of Ikeda.

In reference to claim 10, Ikeda discloses the same invention comprising a working element (14) that is adjustable about its longitudinal axis relative to the other working element (21) and has at least two differently designed working surfaces; and the movable working element (14) and the fixed position working element (21) are releasably connected to one another.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 are rejected under 35 U.S.C. 103 as being unpatentable over United States Patent 5,346,469 Ikeda in view of United States Patent 3,990,452 Murray.

Ikeda discloses the invention substantially as claimed being a surgical ultrasonic instrument. However, Ikeda does not disclose that the movable working-element is rotationally symmetrical.

Murray teaches the use of machine for performing surgery and treatment utilizing ultrasonic energy comprising a movable working-element in a variety of shapes including a rotationally symmetrical embodiment, shown in figures 7a-7f, in the same field of endeavor for the purpose of providing a sleek cutting tool that can be maneuvered to the operation site without cutting any undesired material along the way.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the movable working-element of Murray with the surgical ultrasonic instrument of Ikeda in order to provide a more sleek and easily maneuverable working element.

Response to Arguments

Applicant's arguments filed 7/27/05 have been fully considered but they are not persuasive. Applicant argues that the invention of Ikeda fails to disclose a working space comprising a cutting edge. As disclosed above Ikeda discloses the cutting edge at the tip of element (14) located within the working space described in 2:47-68 and 5:46-68

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Prone whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday Through Fri 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3738

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CP

CDP

Christopher D Prone
Examiner
Art Unit 3738

CZ

CORRINE McDERMOTT
SUPERVISORY PATENT EXAMINER
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